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In re Application of  
EATHERTON et al.  
Application No. 10/528,592  
PCT No.: PCT/EP03/10935  
Int. Filing Date: 25 September 2003  
Priority Date: 27 September 2002  
Attorney Docket No.: P33117USW  
For: PYRIDINE DERIVATIVES AS CB2  
RECEPTOR MODULATORS

DECISION ON PETITION  
UNDER 37 CFR 1.181

This decision is issued in response to applicants' "Request for Reconsideration of Petition for Withdrawal of Abandonment under 37 CFR 1.181(a)" filed in the Patent and Trademark Office (PTO) on 14 November 2006. No petition fee is required.

**BACKGROUND**

On 25 September 2003, applicants filed international application no. PCT/EP03/10935 which claimed a priority date of 27 September 2002. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 08 April 2004. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 27 March 2005.

On 21 March 2005, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, inter alia, the basic national fee; a copy of the international application; and a preliminary amendment.

On 17 November 2005, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 04 August 2006, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Abandonment indicating that the application was abandoned for

failure to respond to the Notification of Missing Requirements mailed 17 November 2005.

On 17 August 2006, applicants filed a "Petition for Withdrawal of Abandonment under 37 CFR 1.181." (The petition included a copy of the declaration purportedly filed on 08 December 2005.) In a decision dated 26 October 2006, applicants' petition under 37 CFR 1.181 was dismissed without prejudice.

On 14 November 2006, applicants filed "Request for Reconsideration of Petition for Withdrawal of Abandonment under 37 CFR 1.181(a)." The petition requests withdrawal of the holding of abandonment, stating that a response to the Notification Of Missing Requirements was timely filed via facsimile on 08 December 2005.

### DISCUSSION

The present petition is accompanied by a document entitled "Response To Notification Of Missing Requirements Under 35 U.S.C. 371" that references an attached declaration, contains the authorization to charge Deposit Account No. 07-1392 the required surcharge, and bears a "Certificate of Transmission by Facsimile" dated 08 December 2005. The Certificate of Mailing, executed by Valerie L. Phillips, states that the accompanying materials were transmitted to the USPTO by facsimile. The petition also includes a copy of an executed declaration, and the confirmation report from applicants' facsimile machine.

The application file does not contain the materials purportedly filed by facsimile on 08 December 2005. In order to confirm the 08 December 2005 filing of the materials accompanying the present petition, applicants must satisfy the requirements set forth in 37 CFR 1.8(b), which states the following:

In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the U.S. Patent and Trademark Office after a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence, or after the application is held to be abandoned, or after the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

- (1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;
- (2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and
- (3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the

previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement..

The evidence filed with the present petition is convincing that the 08 December 2005 response included a declaration with a certificate of facsimile transmission. Additionally, applicants have: (1) informed the Office of the previous mailing of the correspondence promptly after becoming aware that the Office did not receive the items transmitted on 08 December 2005, (2) supplied copies of the previously mailed correspondence; and (3) included a statement by Valerie Phillips which attests on a personal knowledge of the 08 December 2005 transmission. Additionally, petitioner has provided a copy of the sending unit's report confirming transmission on 08 December 2005.

The declaration submitted on 17 August 2006 will be considered as a timely response to the Notification of Missing Requirements mailed 17 November 2005; however, the declaration will be given a receipt date of 17 August 2006. (See 37 CFR 1.8(a))

As the declaration was filed after 30 months from the priority date, the required surcharge of \$130 under 37 CFR 1.492(h) will be charged to Deposit Account No. 07-1392.

Accordingly, it is considered appropriate to withdraw the holding of abandonment.

### CONCLUSION

As construed above, applicants' petition under 37 CFR 1.181 to withdraw the holding of abandonment is GRANTED. The Notification of Abandonment mailed on 04 August 2006 is hereby VACATED.

Deposit Account No. 07-1392 will be charged a \$130.00 surcharge fee under 37 CFR 1.492(e) for supplying an oath or declaration later than 30 months from the earliest claimed priority date, as authorized.

The application has an international filing date of 25 September 2003 under 35 U.S.C. 363, and a 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) date of 17 August 2006.

This application is being forwarded to the National Stage Processing Branch of the International Division for further processing.



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